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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,256	12/05/2000	Shigehito Oba	U-Wp-5562 Akao	8112

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EXAMINER

ZURITA, JAMES H

ART UNIT PAPER NUMBER

3625

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/730,256

**Applicant(s)**

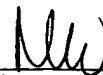
OBA, SHIGEHITO

**Examiner**

James H Zurita

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-8 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-8 and 12-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Prosecution History***

Applicant filed 5 December 2000, claiming priority to Japanese application 242059/2000, filed on 10 August 2000.

A preliminary amendment of 5 December 2000 added claims 9-14.

A First Office Action of 10 March 2004 rejected claims 1-14 as obvious over Jack (US Patent 5,915,244).

### ***Response to Amendment***

Applicant amendment of 16 August 2004 cancelled claims 2 and 5 and amended each remaining claim.

Claims 1, 3, 4, 6-8 and 12-14 are pending and will be examined.

### ***Response to Arguments***

In regard to claim objections, applicant states that "...claims 2 and 4 have been amended to refer to ..." This appears to be word processing error, since claim 2 has been cancelled, and its limitations appear to have been incorporated into claim 1, as per page 15 of applicant's arguments. See also page 22, line 2, of applicant's comments, which still refers to cancelled claim 2.

Applicant argues that the reference does not disclose

- distributing books having different price gifts and different price ranges of gifts and references to specifications pages 8-9, are not recited in the rejected claim(s), page 24.

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- regulating the relation between a thank-you gift administrator and gift dispatch agents, page 26, first paragraph.

In response to these arguments, it is noted that the features upon which applicant relies are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Claim Objections***

Claim 3 is objected to because of the following informalities:

Claim 3 reads "...The method of claim 2, further comprising..." This appears to be a word processing error, and will be interpreted to read "...The method of claim 1, further comprising..." since claim 2 is cancelled.

Claim 3 refers to "...stopping the administrative process.." There is insufficient antecedent basis for this limitation in the claim. The term process is not otherwise mentioned in the claims.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 4 and claims dependent thereupon are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

It is noted that certain claims appear to recite technology, but the technology is involved in a trivial manner. Other claims contain nonfunctional descriptive material. For example, **Claims 1 and 4** provide for several steps that do not recite the use of technology; the steps may be performed without the use of technology: "...distributing books of ..." "...having the customers notify ...administrator..." "having ....administrator give an instruction..."

**Claim 1** refers to "...making an enquiry to the customer by the (thank-you gift information) administrator in the event that a customer fails to communicate regarding at least one of a name and number of a chosen thank-you gift even after a predetermined period of time..." and does not include technology. The disclosures reveal that the enquiry is performed by mailing a postcard.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3, 4, 6-8 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jack et al (US 5915244) in view of Suzanne **Davis**, Dealer Incentive Strategy Guide, Incentive, New York, April 1996, vol. 170, Iss. 4, page 31, 7 pages, downloaded from ProQuest/Internet on 10 November 2004.

**As per claims 1 and 4**, Jack discloses methods, comprising the steps of:

- a) distributing catalogs of awards to customers (applicant's "...books of thank-you gifts..."). See, for example, at least Col. 6, lines 49-57.
- b) customers notify a administrator of at least one of names and numbers assigned to chosen gifts, via one of the following ways: a) through a management of a site of the event, and b) directly. Customers notify an administrative center (applicant's administrator). See, for example, at least Col. 11, lines 24-37. See also references to administering incentive programs, at least Col. 1, line 37-Col. 2, line 3. See references to administering incentive programs, at least Col. 1, line 37-Col. 2, line 3. To choose a gift, customers may speak to customer representatives, who acts as agent of the administrator. See, for example, Fig. 4, item 74 and related text. Customers may also choose their gifts automatically with the administrative computer. See, for example, Fig. 4, item 78 and related text.
- c) administrator give an instruction to redemption centers (applicant's thank-you gift dispatch agent) based on at least one of the names and numbers of said

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chosen gifts so that the chosen gifts are dispatched to the customers.

Customers select their gifts based on at least one of the names and numbers of said gifts. See, for example, references to item number of a desired gift, Col. 11, lines 23-37. The administration center selects the gift from inventory (item 84) and processes the order (see at least Fig. 4, item 92). Redemption centers dispatch awards to customers. See, for example, Fig. 4 and related text, Col. 8, line 28-Col. 9, line 18. See also at least references to shipping of goods, for example, Col. 11, lines 37-53, Fig. 11, item 170, Fig. 4, item 94.

(d) storing information regarding at least addresses and names of the customers in a computer memory. See, for example, at least Col. 7, line 60-Col. 8, line 4. Jack discloses that the administrator, after predetermined periods of time and based on computer reports (applicant's output signals from a computer), identifies customers who have not ordered their gifts. See, for example, references to reports concerning unused credits, at least Col. 1, line 36-Col. 2, line 44.

(e) making an enquiry to the customer by the administrator in the event that a customer fails to communicate regarding at least one of a name and number of a chosen gift even after a predetermined period of time. See, for example, at least Col. 5, lines 25-33, which show that when programs are over, administrative personnel may ask customers to obtain a gift.

(f) dispatching a gift by an administrator to the customer based on an output signal from a computer. See at least references to shipping of goods, for example, Col. 11, lines 37-53, Fig. 11, item 170, Fig. 4, item 94. For

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administrator, see references to administering incentive programs, at least Col. 1, line 37-Col. 2, line 3. See references to customers calling a customer representative, who is an agent of the administrator. Customers may speak to customer representatives (see, for example, Fig. 4, item 74 and related text. Customers may also place their orders automatically. Information is then sent to redemption centers that are responsible for sending the gifts to customers. See references to redemption centers, at least Col. 8, line 41-Col. 9, line 10.

**As per claims 1 and 4**, Jack **does not** specifically disclose that the catalogs are distributed at an event. Davis discloses the use of incentive programs, catalogs may be distributed at award ceremonies. See page 5, paragraph 3, for example. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Jack and Davis to disclose distributing catalogs at an event. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Jack and Dealer Incentive to disclose distributing catalogs at an event for the obvious reason that recognizing winners at special award ceremonies allows recipients to shine and be recognized by their colleagues.

**As per claim 3**, Jack discloses stopping the administrative process regarding the customer, by said administrator if the customer still fails to reply within a certain period. Programs have start and finish dates. See, for example, Col. 4, lines 43-55. At the end of the program period, administrators may stop the program by closing each customer's account. See, for example, Col. 4, lines 26-41.



**As per claims 6 and 9**, Jack discloses that catalogs to be distributed are different from each other in terms of one of prices of the gifts and price ranges of the gifts. See, for example, references to price ranges, at least Col. 5, line 1-Col. 7, line 17.

**As per claims 7 and 13**, Jack *does not* specifically disclose that remote redemption centers (applicant's thank-you gift dispatch agents) may be classified by region. Jack discloses that gifts may be shipped to customers at various locations from remote redemption centers. See, for example, at least Fig. 6 and related text. Fig. 6 shows that gifts may be shipped to various states and countries. Jack also discloses particular instructions to warehouses and delivering carriers. Jack discloses that the system calculates shipping costs and incorporates them into the price ranges and plateau pricing for the catalog gifts. Jack also discloses that customers may call the toll-free number of a remote redemption center responsible for mailing awards to participants. It would have been obvious to one of ordinary skill in the art at the time the invention was made to extend Jack to disclose classifying remote redemption centers (applicant's thank-you gift dispatch agents) by region. One of ordinary skill in the art at the time the invention was made would have been motivated to extend Jack to disclose classifying remote redemption centers (applicant's thank-you gift dispatch agents) by region for the obvious reason that by doing so, the total cost of a gift program may be reduced. This permits the gift-giver to reduce his overall costs and allow the gift-giver to provide recipients with gifts that are more

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expensive or of better quality. Recipients may feel more appreciated and loved if they see that they could receive better-quality, more tasteful gifts.

**As per claim 14**, Jack **does not** specifically disclose providing remote redemption centers (applicant's thank-you gift dispatch agents) which are different from each other in accordance with the types of gifts. Jack discloses that catalogs to be distributed are different from each other in terms of one of prices of the gifts and price ranges of the gifts. See, for example, references to price ranges, at least Col. 5, line 1-Col. 7, line 17. Jack also discloses that employees may be given gifts according to their performance. For example, see at least references to salesmen and quotas, at least Col. 7, lines 20-39. It is well known that in groups, some individuals may have more prestige than others. In the businesses disclosed by Jack, for example, some employees might be janitors. Other employees might be attorneys, or corporate officers, such as presidents and chairmen of the board. Gifts awarded to a president may be much more expensive than gifts awarded to a janitor.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to extend Jack to disclose providing remote redemption centers (applicant's thank-you gift dispatch agents) which are different from each other in accordance with the types of gifts. One of ordinary skill in the art at the time the invention was made would have been motivated to extend Jack to disclose providing remote redemption centers (applicant's thank-you gift dispatch agents) which are different from each other in accordance with the types of gifts for the obvious reason that redemption centers that offer gifts to

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janitors would likely be different from redemption centers that offer gifts to presidents and other officers and professionals.

By providing remote redemption centers (applicant's thank-you gift dispatch agents) which are different from each other in accordance with the types of gifts, it is possible to permit the president and other officers to feel better rewarded than persons of lesser prestige. Again, recipients may feel more appreciated and loved if they see that they could receive better-quality, more tasteful gifts, from more prestigious centers. Otherwise, the more prestigious persons may lose face with their friends.

**As per claim 12**, Jack discloses distributing catalogs of awards to customers ("...books of thank-you gifts..."). See, for example, at least Col. 6, lines 49-57. Jack discloses that catalogs to be distributed are different from each other in terms of one of prices of the gifts and price ranges of the gifts. See, for example, references to price ranges, at least Col. 5, line 1-Col. 7, line 17.

**As per claims 13, 14**, Jack discloses that the administrative center instruct redemption centers (applicant's thank-you gift dispatch agent) based on at least one of the names and numbers of said chosen gifts so that the chosen gifts are dispatched to the customers. Customers select their gifts based on at least one of the names and numbers of said gifts. See, for example, references to item number of a desired gift, Col. 11, lines 23-37. The administration center selects the gift from inventory (item 84) and processes the order (see at least Fig. 4, item 92). Redemption centers dispatch awards to customers. See, for

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example, Fig. 4 and related text, Col. 8, line 28-Col. 9, line 18. See also at least references to shipping of goods, for example, Col. 11, lines 37-53, Fig. 11, item 170, Fig. 4, item 94.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.-

Employees buy awards with rideshare points, Personnel Journal, Santa Monica, January 1993, vol. 72, Iss. 1, page 66 , 6 pages, downloaded from ProQuest/Internet on 10 November 2004.

UGive.comm. chosen by NBCi's XOOM.com as Co-branded gift site, Business wire, New York, 14 December 1999, 3 pages, downloaded from ProQuest/Internet on 10 November 2004.

Association of Incentive Gift Certificate Suppliers, Incentive, New York, August 1996, vol 169, Iss. 8, page SS!, 15 pages, downloaded from ProQuest/Internet on 4 November 2004.

Larking, Corine, How to be an Exhibitionist, Asian Business, Hong Kong, October 1991, vol. 27, Iss. 10, page 56, 4 pages, downloaded from ProQuest/Internet on 10 November 2004.

Doyle, Kevin, Japan, A new frontier for Incentives, Incentive, New York, May 1993, vol. 167, Iss. 5, page 31, 4 pages, downloaded from ProQuest/Internet on 15 November 2004.

Gines, Karen, Gift certificates, Incentive, New York, February 1999, page 1, 15 pages, downloaded from ProQuest/Internet on 10 November 2004.

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Filipczak, Bob, Why no one likes your incentive program, Training, Minneapolis, August 1993, vol. 30, Iss. 6, page 19, 7 pages, downloaded from ProQuest/Internet on 22 November 2004.

Association of Incentive Gift Certificate Suppliers, Incentive, New York August 1995, vol. 169, Iss. 8, page SS!, 15 pages, downloaded from ProQuest/Internet on 11 November 2004.

The Easy to Please reward, Incentive, New York, February 1997, page 2, 14 pages, downloaded from ProQuest/Internet on 10 November 2004.

Klein, Linda, Marketing Vision, Business Atlanta, February 1997, vol. 16, Iss. 2, Sec. 1, page 90, downloaded from ProQuest/Internet on 10 November 2004.

The Individual Award, Incentive, New York, February 1998, page 3, 25 pages, downloaded from ProQuest/Internet on 10 November 2004.

A gift is a reward is an incentive, Incentive, New York, August 2000, part 2, page 8, 13 pages, downloaded from ProQuest/Internet on 10 November 2004.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory

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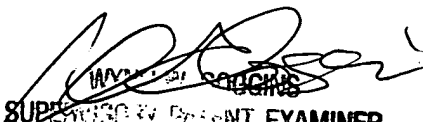
period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James Zurita  
Patent Examiner  
Art Unit 3625  
23 November 2004

  
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